Amendment Under 37 C.F.R. §1.111
U.S. Patent Appln. No. 09/672,329
Docket No. BOC9-2000-0032 (178)

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103(a) as being unpatentable over Palomo in view of U.S. Patent No. 6,434,455 to Snow *et al.* (Snow).

In response, the Applicants have amended claims 1, 8, and 10 to clarify that the present invention includes a method for a vehicle user to operate a self-contained in-vehicle navigation device without the assistance of a third party. Support for these amendments can be found in the Applicants' specification, as detailed later herein. Additionally, dependent claims 12 and 13 have been added to emphasize particular embodiments where the portable storage medium of claim 8 can be an optical disk and/or a removable solid state memory device. Support for these amendments can be found on page 7, lines 5-9 of the Applicants' specification. Accordingly, no new matter has been added. In consequence of these amendments, claims 1-13 are now pending.

Claims 1 and 10 have been rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner has indicated that there is insufficient antecedent basis for specified limitations within the cited claims. In response, the Applicants have amended claims 1 and 10 to include proper antecedent basis for the limitations noted by the Examiner. Accordingly, withdrawal of the 35 U.S.C. § 112 rejections to claims 1 and 10 is respectfully requested.

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is appropriate. The present invention concerns a vehicle navigation method and apparatus that allows a user to select and store navigational information for a self-contained in-vehicle navigation device using input devices that are external to the in-vehicle navigation device. Once entered by a user and stored within a memory remote from the in-vehicle navigation device, the navigational information can be transferred to the in-vehicle navigation device. The user can then navigate the vehicle to a destination specified by the navigational information using the in-vehicle navigation device.

The present invention resolves problems relating to the inconvenient and ergonomically unfavorable manner in which data typically is entered into conventional in-vehicle navigation devices. Further, the method allows vehicle users to contemplate

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and plan among different destination alternatives in the comfort of their home or office, using available computing resources, such as a personal computer or a handheld computer. Travel related information, which can be provided by a Web site, can assist the user in identifying and storing navigational information later used by the vehicle navigation device.

Turning to the rejections on the art, claims 1, 2, 3, 4, 5, 7, 8, 9 and 11 have been rejected under 35 U.S.C. §102(e) as being anticipated by Palomo. In particular, it has been asserted that Palomo discloses a method for externally inputting navigational information, storing this information in a memory location remote from the vehicle, and transferring this information into an in-vehicle navigation system. Palomo, however, does not teach a method where a <u>vehicle user</u> can, without assistance, externally input navigational information for an in-vehicle navigational system. Rather, Palomo requires the involvement of a third party agent to program, store, and assist in the transfer of destination information. <u>In fact, according to Palomo, the task of programming and operating an in-vehicle navigation system is too complex for a typical vehicle user to perform without the assistance of a trained third party.</u> In support, the Applicants note:

- Column 1, lines 63-66. "[V]ehicle rental customers typically are unfamiliar with the programming and operation of the various different makes and models of in-vehicle navigation system[s]."

- Column 2, lines 2-5. "Thus, because the programming of intended destinations is time consuming and difficult, vehicle rental customers typically do not use the in-vehicle navigation system to locate destinations as intended by the manufacturer."

- Column 2, lines 29-33. "[A] method and apparatus is needed for locating an intended destination that does not require the user to be familiar with the complexities of programming a particular model of in-vehicle navigation system."

- Column 3, lines 10-16. "This allows a user who is unfamiliar with the complex programming and operation of a prior art in-vehicle navigation system to easily find intended destinations. There is no need for the user to read the

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instruction manual of the in-vehicle navigation system and/or otherwise learn how to program specific destinations into the in-vehicle navigation system."

• Column 6, lines 5-11. "[O]perator obtain[s] information from customer pertaining to the vehicle rental, operator asks customer to list his intended destinations during the rental. Customer then verbally lists intended destinations. The intended destinations are then input into a computing device [by the operator]."

Thus, Palomo does not teach an unassisted vehicle navigation method where a user can input navigational information into an in-vehicle navigation system. Rather, Palomo teaches a method where a user lacking the ability to program and operate an in-vehicle navigation device, a vehicle rental customer, can utilize an in-vehicle navigation system through the assistance of a more skilled operator, an agent of a rental car facility.

In contrast, the Applicants' invention allows a vehicle user to program and operate an in-vehicle navigation system without assistance. Indeed, the Applicant's invention provides an alternate method for programming navigational information remote from the vehicle navigation system so that the user is not confined to the input peripherals of the in-vehicle navigation system. See page 4, lines 4-9. Additionally, the users can identify and store navigational information at a location of choice, such as at home or in the user's office, instead of being forced to enter navigational information within the confines of a vehicle. See page 4, lines 10-12. Palomo conflicts with both of these objectives by (1) not providing an external input means by which the user can enter and store navigational information and (2) not allowing the user to identify and store information at a location of the user's choice. In consequence, Palomo does not teach or suggest each limitation of the Applicants' invention as claimed. Accordingly, withdrawal of the 35 U.S.C. §102(e) rejection of claims 1, 2, 3, 4, 5, 7, 8, 9 and 11 is respectfully requested.

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In paragraph 9 of the Office Action, claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over by Palomo in view of Rennard. The Examiner concedes that Palomo does not disclose the use of a Web site in identifying destination information. The Examiner contends, however, that Rennard's use of a Web site to "provide an improved operating environment that allows a user to input complex information through alternative devices ahead of time" combined with the teachings of Palomo renders claim 6 of the present invention obvious. The Applicants respectfully disagree.

As previously discussed, the Palomo invention describes a method where a vehicle navigational system can be used without a user programming information into the navigational system. Indeed, Palomo teaches that users lack the sophistication to program and operate a navigation system without the assistance of a third party. Rennard, on the other hand, teaches the use of a Web site as a convenient alternative environment for user input. Consequently, since users of the Palomo invention explicitly do not input information, one would not turn from Palomo to Rennard for alternative input environments. Indeed, objectives fulfilled by Palomo render teachings of a user input environment moot as Palomo is explicitly confined to use within a rental car environment having skilled agents. Therefore, Applicants assert that the teachings of Rennard conflict with the teachings of Palomo and that Rennard and Palomo should not be combined in the manner suggested in paragraph 9 of the Office Action.

Furthermore, the Applicant's respectfully disagree in general with the Examiner's interpretation that the teachings in Rennard are applicable to the limitation of claim 6 of the present invention, as presently amended. Rennard teaches a system including a portable navigation device that communicates with a navigational server, wherein the navigational server performs the navigational tasks of the disclosed system. In performing these tasks, the navigational server, which is a network element, requires inputs specifying destination data. In the embodiment cited at column 11, lines 4-34 by the Examiner, destination data inputs must be conveyed through the Internet to the navigational server in order for the system to function. Rennard states that supplying

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the required inputs through a navigation device that is so limited as to not be capable of independent navigation can be cumbersome. Hence, Rennard contemplates a Web site where a user can supply required information to a network element that performs navigational tasks.

In contrast to Rennard which supplies information through a Web site, the present invention extracts or gathers information from a Web site. Unlike Rennard which uses a Web site to provide required information, the Web site of the present invention relays supplemental navigational information. As previously noted, the portable navigation device of Rennard lacks the ability to independently perform navigational functions. Instead, in Rennard navigational computations are performed within a navigational server and communicated to the portable navigation device. Hence, the Rennard invention describes a portable device for receiving and presenting information and does not describe a self-contained navigational device capable of independent navigational operations, as is described in the present invention. This distinction is extremely significant because many operational environments in which the present invention functions, such as a remote highway, can lack the communicative capabilities necessary for system described in Rennard. Accordingly, the Rennard system has operational limitations that the present invention overcomes. As neither Palomo, Rennard, nor any combination thereof teach or suggest the present invention, withdrawal of the 35 U.S.C. §103(a) rejection of claim 6 is respectfully requested.

Claim 10 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Palomo in view of Snow. The Examiner has conceded that Palomo does not disclose the use of a queue to remove navigational information when the navigation device is connected to a network. The Examiner has cited column 5, lines 23-25 of the Snow specification as teaching a method of removing navigational information from a navigational system using a queue. Applicants respectfully disagree with this interpretation and assert that Snow teaches a diagnostic and update system for vehicle maintenance, which is entirely unrelated to vehicle navigation. As Snow includes no teaching relating to "removing navigational information from a navigational system" or to

navigational systems in general, one skilled in the art of vehicle navigation would not turn to Snow for a solution to the problems addressed by the present invention. Therefore, no motivation exists to combine the teachings of Snow and Palomo.

Assuming arguendo that some motivation to combine Snow and Palomo does exist, however, Snow still fails to anticipate claim 10 of the present invention. Claim 10, as amended, places navigational information stored within a first memory external to an in-vehicle navigation system. This navigational information can be placed in a queue so that when a network connection is established between the first memory and the in-vehicle navigation system, the navigational information can be transferred to the in-vehicle navigation system in response to at least one input entered by the user.

Unlike the present invention, which is performed by the user of the vehicle, Snow requires the involvement of a third party, a service technician. See column 1, lines 21-23. Snow does not allow networked communications with an in-vehicle computing device, but instead involves networking between two computing devices, neither of which is integrated with a vehicle. See column 2, lines 44-45. In Snow, vehicle information travels from a vehicle to a server. See column 5, lines 18-21. The present invention, however, conveys information from a server to a vehicle. Additionally, in Snow, information exchanges with a vehicle and a server require third party involvement, intervening steps, and additional temporary equipment. See column 4, lines 39-52. The present invention performs data exchanges with the in-vehicle navigation system directly, without intervening steps or additional temporary equipment. As neither Palomo, Snow, nor any combination thereof teach or suggest the present invention, withdrawal of the 35 U.S.C. §103(a) rejection of claim 10 is respectfully requested.

In light of the preceding remarks, withdrawal of the rejections of claims 1-11 is respectfully requested. The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this
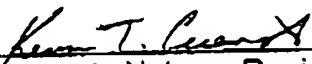
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Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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